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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,303	11/02/2000	Timothy Gephart Kirkpatrick	2030743-0001	4931

7590 01/11/2005

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EXAMINER
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HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/704,303

**Applicant(s)**KIRKPATRICK, TIMOTHY  
GEPHART**Examiner**

Lalita M Hamilton

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Summary**

On July 30, 2004, an Office Action was sent to the Applicant rejecting claims 1-47. On October 19, 2004, the Applicant responded by filing a rule 1.131 Affidavit, amending claim 19, and adding new claim 47.

### **Affidavit filed under 37 CFR 1.131**

The affidavit filed on October 19, 2004 under 37 CFR 1.131 is sufficient to overcome the Loy reference.

### ***Claim Rejections - 35 USC § 112***

The rejection set forth in the previous Office Action has been withdrawn.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-40 and 45-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-40 and 45-46 are rejected under 35 U.S.C. 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no

more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

-A computer implemented method for --- , or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Savage (US 2002/0026394).

Savage discloses a method and corresponding system for billing involving trade receivables, which the Examiner is interpreting as having the capability of being utilized interchangeably with a grantor/grantee, lessor/lessee, or licensor/licensee comprising

forwarding information regarding at least one receivable from a grantor to at least one potential grantee, offering a purchase option to the potential grantee, the purchase option providing the potential grantee the right but not the obligation to purchase the receivable, the purchase option providing the grantor with an obligation to sell the receivable, offering, by the potential grantee to the grantor, an option fee (discount) accepting the option fee by the grantor from the potential grantee, acceptance of the option fee by the grantor constituting an acceptance by the grantor of the purchase option from the potential grantee and thereby providing the potential grantee the right to purchase the receivable at or before the end of an option period, and in the offering a purchase option includes establishing a notification date where the notification date being a date on or before which the potential grantee is required by the purchase option to provide notification to the grantor regarding purchase of the receivable, offering, by the potential grantee to the grantor, an option fee, wherein the option period is a time period that exists between the accepting the option fee by the grantor and the notification date (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); forwarding information regarding at least one receivable from a grantor to at least one potential grantee, offering an option to the potential grantee, the option providing the potential grantee the right but not the obligation to acquire the receivable, the option providing the grantor with an obligation to convey the receivable, offering, by the potential grantee to the grantor, an option fee, accepting the option fee by the grantor from the potential grantee, acceptance of the option fee by the grantor constituting an acceptance by the grantor of the option from the potential grantee and thereby providing the potential

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grantee the right to acquire the receivable at or before the end of an option period, and notification date being a date on or before which the potential grantee is required by the option to provide notification to the grantor regarding acquisition of the receivable, wherein the option period is a time period that exists between the accepting the option fee by the grantor and the notification date (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); at least one receivable is a collection of receivables (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); distributing non-confidential information from the grantor to the potential grantee determining if the potential grantee requested confidential information, and forwarding confidential information from the grantor to the potential grantee if the potential grantee requested confidential information (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); the potential grantee offers to the grantor a purchase price offer for the receivable, along with the option fee offer, in return for the right to pay the purchase price at a later time (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); determining that the information about the potential grantee and determining that the information satisfies a list of requirements (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); the list of requirements is established by the grantor (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); forwarding, from the potential grantee to the grantor, notification regarding exercise by the potential grantee of the purchase option (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); the notification is forwarded on or before the notification date (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); if the grantee does not wish to accept the receivables, then the notification includes the grantee communicating to the grantor that the grantee does not

wish to accept the receivables and if the grantee does wish to accept the receivables, then the grantee providing no communication to the grantor that the grantee accepts the receivables, thereby providing notification by the absence of any communication (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); the grantee pays the purchase price and the receivables are conveyed from the grantor to the grantee (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); the potential grantee relinquishes and the grantor retains the option commitment fee (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); determining the amount of the option fee based on the length of the option period (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); increasing the option fee as the length of the option period increases (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); forwarding information regarding at least one receivables from a grantor to at least one potential grantee step is performed utilizing a computer (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); a computer determines the amount of the option fee, the computer determining the option fee based on the information regarding at least one receivables and terms of the purchase option (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); the third party is an agent of the primary grantee (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); providing online collection services comprising clients utilizing collections services (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108); and collection of receivables including at least one selected from the group of charged-off consumer receivables, charged-off commercial receivables, delinquent consumer receivables and delinquent commercial receivables (p.3, 21; p.5-6, 56; p.7, 64; p.9, 72; and p.15, 107-108).

***Response to Arguments***

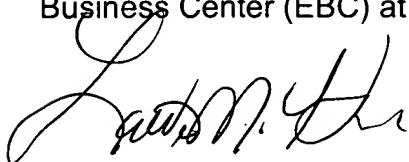
Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Lalita M. Hamilton', is written over the printed name 'LMH'.

LMH